

REMARKS

Claims 13 and 14 have been amended to correct informalities. No new matter has been added. Upon entry of this Amendment, claims 1-16 remain pending.

In the Office Action dated January 5, 2005, claim 13 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. Claim 13 has been amended to correct the informality pointed out by the Examiner. Accordingly, Applicants respectfully request that the rejection to claim 13 be withdrawn.

In the Office Action, claim 14 was rejected under 35 U.S.C. §102(b) as being anticipated by Kendall (U.S. Patent No. 5,532,903). Applicants respectfully traverse this rejection.

Claim 14 recites a lithographic projection apparatus that includes, *inter alia*, means for projecting a patterned beam of radiation onto a target portion of a substrate, holding means for holding at least one of a patterning device and the substrate, and means for resiliently supporting the holding means.

Kendall does not even disclose a lithographic projection apparatus, as conceded by the Examiner in the Office Action. Instead, the Examiner states “the use of the disclosed holding means for its disclosed purpose inherently requires such lithographic apparatus.” (Office Action, page 2.) MPEP §2112 makes it clear that in order to establish inherency, “the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference’...” (MPEP §2112.) Here, it is a membrane electrostatic chuck that is described by the reference. (Kendall at abstract.) A lithographic projection apparatus is not “necessarily present” in the chuck. Moreover, the chuck is not “necessarily present” in a lithographic apparatus. Kendall states that “[t]he invention is *generally related* to electrostatic chucks used in high vacuum applications for patterning and processing substrates *such as* semiconductor chips and wafers.” (Kendall at col. 1, lns. 7-9, emphasis added.) Thus, the use of such a chuck does not “inherently require” a lithographic apparatus, as asserted by the Examiner. Accordingly, Applicants respectfully request that the rejection to claim 14 be withdrawn.

Applicants appreciate the indication that claims 1-12, 15, and 16 are allowed and that claim 13 would be allowable if amended to overcome the rejection under 35 U.S.C. §112, second paragraph, discussed above.

All rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited. If any point remains at issue which the Examiner feels may best be resolved through a personal or telephone interview, please contact the undersigned at the telephone number below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
PILLSBURY WINTHROP
SHAW PITTMAN LLP



EMILY T. BELL
Reg. No. 47,418
Tel. No. 703.905.2261
Fax No. 703.905.2500

Date: May 10, 2005
P.O. Box 10500
McLean, VA 22102
(703) 905-2000